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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046965
Party	Plaintiff Gander Mountain Company
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Gander Mountain Company

Petitioner,

v.

ELM Development, LLC

Registrant.

Cancellation No.: 92046965

Reg. No.: 3,086,200

Mark: THE GANDERGUNMEN

Petitioner's File No.: 7495

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

AMENDED PETITION FOR CANCELLATION

Petitioner Gander Mountain Company, a Minnesota corporation, with its principal place of business at 180 East Fifth Street, Suite 1300, St. Paul Minnesota 55101, believes that it is or will be damaged by Registration No. 3,086,200 issued on the Principal Register on April 25, 2006 to ELM Development, LLC ("Registrant") for the mark THE GANDERGUNMEN for "[e]ntertainment services, namely, production and distribution of a hunting show" in International Class 41 (the "Registration"), and hereby petitions to cancel such registration under the provisions of Title 15 of the U.S. Code. To the best of Petitioner's knowledge, Registrant is the current owner of the Registration and has a principal place of business at 15660 Ramsey Boulevard, N.W. Ramsey, Minnesota 55123.

As grounds for petition, it is alleged that:

Likelihood of Confusion

1. Petitioner is now, and for many years prior to Registrant's claimed first use date of September 2002 has been, engaged in the marketing, sale, and promotion of retail store services in the field of hunting, fishing and camping equipment and clothing and apparel under

the GANDER MOUNTAIN mark. Petitioner is one of the nation's largest retailers of firearms, hunting products, and gunsmithing services. Its GANDER MOUNTAIN mark is particularly associated in the mind of consumers with these products and services.

2. Petitioner first began use of the GANDER MOUNTAIN mark to identify its retail store and retail mail order services at least as early as 1960, and the mark has been in such use continuously since then.

3. Petitioner is the owner of several U.S. Trademark Registrations for the marks GANDER MOUNTAIN and GANDER MTN., including the following:

Reg. No. / Reg. Date	Mark	Goods/Services	First Use
1,335,489 May 14, 1985	GANDER MOUNTAIN	<u>Class 16</u> : Outdoor Sportman's Supplies Catalogues <u>Class 42</u> : Retail Mail Order Services in the Field of Outdoor Sportman's Supplies; Retail Store Services Specializing in Outdoor Sportsman's Supplies	Feb. 7, 1960
1,927,194 Oct. 17, 1995	GANDER MOUNTAIN	<u>Class 25</u> : Footwear and Clothing, Namely Shirts, Coats, Jackets, Vests, Sweaters, Pants, Socks, Caps and Hats	July 31, 1992
2,564,297 April 23, 2002	GANDER MOUNTAIN	<u>Class 9</u> : Rifle Scopes <u>Class 13</u> : Rifle Cases, Pistol Cases, and Gun Cases <u>Class 16</u> : Playing Cards <u>Class 21</u> : Mugs <u>Class 28</u> : Deer Hunting Decoys <u>Class 30</u> : Plastic Cigarette Lighters <u>Class 34</u> : Candy	Jan. 7, 2002
2,864,302 July 20, 2004	GANDER MTN.	<u>Class 35</u> : Retail Sporting Goods Store Featuring Outdoor Sportsman's Supplies, Hunting, Fishing and Camping Equipment, Clothing and Apparel, and Motorized and Non-Motorized Vehicles, Namely, Boats, All-Terrain Vehicles (ATVs) and Snowmobiles	Dec. 3, 2002
2,923,383 Feb. 1, 2005	GANDER MTN.	<u>Class 36</u> : Credit Card Services	Aug. 14, 2003

4. On January 2, 2007, Petitioner filed an application for U.S. trademark registration of its mark GANDER MTN. in International Class 36. This mark was registered for the services “financial sponsorship of sporting events, television and radio programs, contests, promotions, charitable events, and educational seminars in the field of hunting and fishing” on October 9, 2007 and bears the registration number 3,305,893.

5. Petitioner first began use and use in interstate commerce of the GANDER MTN. mark to identify its sponsorship services at least as early as 1998, and the mark has been in such use continuously since then.

6. On January 2, 2007, Petitioner also filed an application for U.S. trademark registration of its mark GANDER MTN. in International Class 41. This mark was registered for the services “entertainment in the nature of on-going television programs in the field of outdoor activities” on October 9, 2007 and bears the registration number 3,305,894.

7. Petitioner first began use and use in interstate commerce of the GANDER MTN. mark to identify its ongoing television programs at least as early as January 3, 2004, and the mark has been in such use continuously since then.

8. THE GANDERGUNMEN mark that is the subject of the Registration, when considered in its entirety, is confusingly similar in appearance, sound and commercial impression to Petitioner’s GANDER MOUNTAIN and GANDER MTN. marks.

9. The services covered by the Registration are so closely related to those goods and services covered in Petitioner’s GANDER MOUNTAIN and GANDER MTN. registrations that they fall within Petitioner’s zone of natural expansion, as evidenced by Petitioner’s registrations for nearly identical services as described in Paragraphs 4 through 7. At the time Registrant first used and filed its application for the mark THE GANDERGUNMEN mark, it was foreseeable that Petitioner, a leading provider of hunting products and an avid sponsor of

hunting events, promotions, and television and radio programs, would offer its own television programs and that such use falls within the zone of natural expansion.

10. As stated, Petitioner filed its application for registration of the GANDER MTN. mark in connection with financial sponsorship of sporting events and radio and television programs based on Petitioner's first use of the mark at least as early as 1998.

11. Petitioner's date of first use of the GANDER MTN. mark in connection with its sponsorship activities clearly predates the date of first use claimed in the Registration for the mark THE GANDERGUNMEN, namely, September, 2002.

12. In view of the similarity in sound, meaning, and appearance of the respective marks, the prior use of Petitioner's GANDER MOUNTAIN and GANDER MTN. marks, and the goodwill associated with Petitioner's marks, it is alleged that Registrant's mark THE GANDERGUNMEN, when registered throughout the United States without limitation, in association with the production and distribution of a hunting show, so resembles Petitioner's marks as to be likely to cause confusion, to cause mistake, or to deceive a substantial number or persons to believe, mistakenly, that Registrant's services originate from, or are approved by, or are in some way associated with Petitioner, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Failure to Function as a Service Mark

13. On information and belief, Registrant is not entitled to Registration No. 3,086,200 because the term for which registration has been obtained fails to function as a service mark under Trademark Act Sections 1, 3, 14, and 45, 15 U.S.C. §§ 1051, 1053, 1064 and 1127.

14. Registrant does not use the mark THE GANDERGUNMEN as a service mark in connection with providing services for others. For example, Registrant's specimen consists of a screen shot from one of Registrant's own DVDs, rather than showing or advertising any services offered or provided to third parties.

15. Registrant's use of the mark in connection with the sale of DVDs does not identify Registrant as a provider of production or distribution services for the benefit of others, nor does it associate Registrant's mark with those claimed services. Any video production that Registrant did perform was in producing its own DVDs, which Registrant subsequently offered for sale. This activity was primarily for Registrant's own benefit and is unregistrable as a service. A term that is used only to identify a product sold or used in the performance of a service rather than to identify the service itself does not function as a service mark.

Fraud on the United States Patent and Trademark Office

16. On information and belief, Registrant's mark is invalid because Registrant made one or more material representations of fact to the United States Patent and Trademark Office ("USPTO") that Registrant knew or should have known were false.

17. On information and belief, on December 9, 2003, Registrant filed its intent-to-use service mark application for THE GANDERGUNMEN in connection with "[e]ntertainment services, namely production and distribution of a hunting show." This application was signed by Eric L. Marhoun. Mr. Marhoun was the President of Registrant, and its sole employee.

18. On information and belief, on June 20, 2005, Registrant signed and filed its statement of use for THE GANDERGUNMEN application ("Statement of Use"). In the Statement of Use, Registrant claimed September 2002 as both its first use anywhere date and its first use in commerce date in connection with the provision of production and distribution services related to a hunting show. Registrant also stated that it was currently using THE GANDERGUNMEN in commerce in connection with the provision of production and distribution services related to a hunting show. In connection with its Statement of Use, Registrant submitted a specimen depicting a trailer with the words "Team GanderGunmen The men who brought you hard gravity!" painted on the side. The Statement of Use was signed by Eric L.

Marhoun on June 20, 2005. At the time that he signed the Statement of Use, Mr. Marhoun was the President of Registrant, and its sole employee.

19. On August 10, 2005, the USPTO rejected the Statement of Use, finding that the specimen was insufficient. Specifically, the USPTO stated that specimen was “unacceptable as evidence of actual service mark use [because] it does not show use of the mark in the sale or advertising of the services specified.” Registrant was directed to submit a substitute specimen within six months.

20. On information and belief, on February 10, 2006, Registrant signed and filed a substitute statement of use as its response to the August office action (“Response”). In this Response, Registrant claimed September 2002 as both its first use anywhere date and its first use in commerce date in connection with the provision of production and distribution services related to a hunting show. Registrant also stated that it was currently using THE GANDERGUNMEN in commerce in connection with the provision of production and distribution services related to a hunting show. The Response was signed by Eric L. Marhoun. Registrant submitted a substitute specimen with its Response. This specimen was a screen shot from Registrant’s own “Hard Gravity” DVDs. At the time that he signed the Response, Mr. Marhoun was the President of Registrant, and its sole employee.

21. The USPTO accepted Registrant’s Response on March 7, 2006 and registered THE GANDERGUNMEN trademark on April 25, 2006.

22. On December 12, 2007, as a part of this proceeding, Eric L. Marhoun was deposed both in his individual capacity and as the Federal Rule of Civil Procedure 30(b)(6) designee of Registrant.

23. At the deposition, Mr. Marhoun testified the only video production and distribution services that Registrant has provided were in connection with its own product – i.e., Registrant’s

“Hard Gravity” DVDs. Mr. Marhoun also admitted that Registrant has not provided video production or distribution services for any other third party.

24. Based on Mr. Marhoun’s testimony at his deposition, Petitioner alleges that the following statements made by Registrant in the Statement of Use were false: (a) that Registrant had first used THE GANDERGUNMEN mark anywhere in connection with the claimed services in September 2002; (b) that Registrant had first used the GANDERGUNMEN mark in commerce in connection with the claimed services in September 2002; and (c) that Registrant was currently using the mark in commerce in connection with the claimed services. As of the filing date of its Statement of Use, Registrant had not used the mark in connection with provision of production and distribution services related to a hunting show for third parties.

25. Based on Mr. Marhoun’s testimony at his deposition, Petitioner alleges that the following statements made by Registrant in the Response were false: (a) that Registrant had first used THE GANDERGUNMEN mark anywhere in connection with the claimed services in September 2002; (b) that Registrant had first used the GANDERGUNMEN mark in commerce in connection with the claimed services in September 2002; and (c) that Registrant was currently using the mark in commerce in connection with the claimed services were false. As of the filing date of its Response, Registrant had not used the mark in connection with provision of production and distribution services related to a hunting show for third parties.

26. It is further alleged that at the times that Mr. Marhoun signed the Statement of Use and the Response, he was the President of Registrant, and its sole employee. Therefore, at the time that he signed these documents, he knew or should have known that Registrant was not currently using, nor had it ever used THE GANDERGUNMEN in connection with the provision of video production or distribution services to any third party.

27. It is alleged that the USPTO relied on Registrant's false statements in issuing a federal registration for THE GANDERGUNMEN and that such statements were material to the prosecution of the application.

28. It is alleged that Registrant has committed fraud in procuring a registration for THE GANDERGUNMEN, thus making the registration void.

29. By virtue of the foregoing, Petitioner believes that it is and will be damaged by the continued existence of the Registration because the Registration improperly narrows Petitioner's rights in its GANDER MOUNTAIN AND GANDER MTN. registrations and prevents the registrations from achieving their full statutory benefits. Further Petitioner is and will be damaged by the continued registration of Registrant's mark because Registrant will enjoy unlawful gain and advantage to which it is not entitled under the Lanham Act, 15 U.S.C. §§ 1051, et seq.

WHEREFORE, Petitioner prays that said Registration No. 3,086,200 be canceled and that this petition be sustained in favor of Petitioner.

Respectfully submitted,

GANDER MOUNTAIN COMPANY

Date: July 9, 2008.

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ATTORNEYS FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document has been served via first-class mail, postage prepaid, to Christopher J. Schulte and Heather J. Kliebenstein of Merchant & Gould P.C., 3200 IDS Center, 80 South Eighth Street, Minneapolis, Minnesota 55402 this 9th day of July, 2008.

/Kevin S. Ueland/
Kevin S. Ueland, Esq.